UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,591	11/28/2001	Stefan Berndt	112740-357	6228

29177 7590 05/18/2006

BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
WOO, ISAAC M	

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,591	BERNDT, STEFAN	
	Examiner	Art Unit	
	Isaac M. Woo	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 February 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 23, 2006 has been entered.

2. Claims 1-2, 4-5 and 8-9 are amended. Claim 3 is canceled. Claims 1-2 and 4-9 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2 and 4-8 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claim 1 for limitation, "A unit for managing data stored in a first data processing device", includes *no physical structure of the machine in terms of its*

hardware or hardware and software combination. Because claim limitation of "a first interface", "a second interface", and "a third interface" are software program functions. Thus, claims 1-2 and 4-8 are software, per se. Therefore, the claims are not a statutory and should be rejected under 35 U.S. C. § 101 as not being tangible.

Claim Objections

5. Claims 1-2 and 4-8 are objected to because the preamble of claim 1 of the "A unit" does not provide specific claim statutory type, such as, method, system or apparatus, etc. Thus, it requires specifying claim statutory type.

Claim 9 is objected to because the meaning of "a unit" in line 2, does not have clear support from specification if "a unit" is "a software unit" or "a hardware unit". Examiner interprets "a unit" as "a system component unit" for claims 1-2 and 4-9.

Appropriate correction is required.

Drawings

6. The drawings filed on 02/26/2002 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Multer et al (U.S. Patent No. 6,671,757, hereinafter, "Multer").

With respect to claim 1, Multer teaches a unit (i.e., system in fig. 8, col. 9, lines 19-60, "a unit" is interpreted as "a system component unit" as discussed above in claim objections) for managing data stored in a first data processing device (i.e., 804, PDA in fig. 8, col. 9, lines 46-60), (i.e., data synchronization between PDA, 804 and Windows PC, 806 in fig. 8, col. 9, lines 18-67 to col. 10, lines 1-18), Multer teaches a first interface to an object-oriented application (i.e., application object is specific to each application, col. 11, lines 58-67 to col. 12, lines 1-41) which initializes access to the data (col. 10, lines 19-32) and affords changes to the data (i.e., user accesses PDA and changes contact information in application data of PDA, col. 11, lines 15-22, fig. 8); Multer teaches a second interface to an access unit (i.e., 806, Windows 95/98/NT in fig.

8, col. 9, lines 60-67 to col. 10, lines 1-5) which provides different access mechanisms for respectively different memory structures (i.e., PDA and Windows 95/98/NT has each different operating system, needs different access mechanism, and different memory structure, fig. 8, col. 9, lines 46-67 to col. 10, lines 1-31), wherein the unit (i.e., system in fig. 8, col. 9, lines 19-60) provides the object-oriented application with appropriate data by accessing the access unit (i.e., specific application data is accessed by user in each different device, fig. 8, col. 9, lines 46-60) and affords changes to the data independent of changes (i.e., independent data change, col. 7, lines 7-19) made to the data via the first interface (i.e., PDA in fig. 8), (i.e., first interface (PDA) and second interface (Winfows95/98/NT) provide application data accesses and change data independently by user, col. 7, lines 7-19, col. 9, lines 46-67 to col. 10, lines 1-31, col. 3, lines 23-32); and a third interface to a consistency (i.e., synchronizing different information, col. 3, lines 32-55) module for automatically updating changes (i.e., synchronizing different information from data, col. 3, lines 32-55) to the data in further object-oriented applications accessing the same data (i.e., synchronizing delta (changed) information for same data in between PDA and Windows 95/98/NT, fig. 2, col. 6, lines 31-47, col. 3, lines 32-67 to col. 4, lines 1-29 in fig. 4-5, fig. 8, col. 7, lines 7-44).

With respect to claim 2, Multer teaches wherein the data are provided as required objects (i.e., data is extracted, copied and stored as application objects requires col. 12, lines, 9-41).

With respect to claim 4, Multer teaches wherein the object-oriented application runs one the first data processing device (i.e., 804, PDA in fig. 8) in which the data is stored (i.e., 814, palm application (object-oriented application in fig. 9B, col. 15, lines 25-43) runs on first data processing device, 824 in fig. 8, application data is stored on PDA, col. 11, lines 23-37).

With respect to claim 5, Multer teaches wherein the object-oriented application runs (i.e., 816, 826 in fig. 8, col. 11, lines 59-67 to col. 12, lines 1-41) on a second data processing device (i.e., 806, Windows 95/98/NT in fig. 8) and the data are stored in the first data processing device (i.e., 824, plam application data stored in 804, PDA in fig. 8, col. 11, lines 23-38), the first and second data processing device being connected to one another via network (i.e., 700, network in fig. 7-8, col. 7, lines 61-67 to col. 8, lines 1-16).

With respect to claim 6, Multer teaches wherein the unit is arranged in the first data processing device (i.e., 814, plam applications are software function unit on 804, PDA in fig. 8, col. 9, lines 46-60).

With respect to claim 7, Multer teaches wherein the first interface is used for connection to a network interface unit (i.e., 710, internet connection in fig. 8, col. 10, lines 46-60).

With respect to claim 8, Multer teaches wherein, for a plurality of object-oriented applications (i.e., 816 in fig. 8, col. 12, lines 9-41), each application has a respectively associated application-specific unit (i.e., 816 in fig. 8, each application, such as, windows, outlook, and etc., has its own specific application software function, col. 9, lines 46-67 to col. 10, lines 1-18, col. 12, lines 9-41).

With respect to claim 9, Multer teaches a system for managing data (i.e., for data synchronization, col. 9, lines 18-67 to col. 10, lines 1-18), Multer teaches a unit (i.e., system in fig. 8, col. 9, lines 19-60, "a unit" is interpreted as "a system component unit" as discussed above in claim objections) for managing the data (i.e., for data synchronization, col. 9, lines 18-67 to col. 10, lines 1-18), the unit including a first processing device (i.e., 804, PDA in fig. 8, col. 9, lines 46-60), a first interface to an object-oriented application (i.e., application object is specific to each application, col. 11, lines 58-67 to col. 12, lines 1-41) which initializes access to the data (i.e., specific application data is accessed by user in each different device, fig. 8, col. 9, lines 46-60) and affords changes to the data (i.e., user accesses PDA and changes contact information in application data of PDA, col. 11, lines 15-22, fig. 8); Multer teaches a second interface to an access unit (i.e., 806, Windows 95/98/NT in fig. 8, col. 9, lines 60-67 to col. 10, lines 1-5) which provides different access mechanisms for respectively different memory structures (i.e., PDA and Windows 95/98/NT has each different operating system, needs different access mechanism, and different memory structure, fig. 8, col. 9, lines 46-67 to col. 10, lines 1-31), wherein the unit (i.e., system in fig. 8,

col. 9, lines 19-60) provides the object-oriented application with appropriate data by accessing the access unit (i.e., specific application data is accessed by user in each different device, fig. 8, col. 9, lines 46-60) and affords changes to the data independent of changes (i.e., independent data change, col. 7, lines 7-19) made to the data via the first interface (i.e., PDA in fig. 8), (i.e., first interface (PDA) and second interface (Winfows95/98/NT) provide application data accesses and changes independently by user, col. 7, lines 7-19, col. 9, lines 46-67 to col. 10, lines 1-31, col. 3, lines 23-32); and Multer teaches a third interface to a consistency (i.e., synchronizing different information, col. 3, lines 32-55) module for automatically updating changes (i.e., synchronizing different information from data, col. 3, lines 32-55) to the data in further object-oriented applications accessing the same data (i.e., synchronizing delta (changed) information for same data in between PDA and Windows 95/98/NT, fig. 2, col. 6, lines 31-47, col. 3, lines 32-67 to col. 4, lines 1-29 in fig. 4-5, fig. 8, col. 7, lines 7-44); and Multer teaches a second data processing device (i.e., 806, Windows 95/98/NT in fig. 8, col. 9, lines 60-67 to col. 10, lines 1-5), wherein the object-oriented application runs (i.e., 816, 826 in fig. 8, col. 11, lines 59-67 to col. 12, lines 1-41) on a second data processing device (i.e., 806, Windows 95/98/NT in fig. 8) and the data are stored in the first data processing device (i.e., 824, plam application data stored in 804, PDA in fig. 8, col. 11, lines 23-38), the first and second data processing device being connected to one another via network (i.e., 700, network in fig. 7-8, col. 7, lines 61-67 to col. 8, lines 1-16).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isaac Woo
May 12, 2006